

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-62 are currently pending in this application. Claims 21-24, 27-28, 31, and 52-55 have been withdrawn from further consideration. Claims 1, 11, 13, 25, 26, 29, 30 and 44, which are independent, have been amended by this response. Claim 3 has been canceled without prejudice or disclaimer of subject matter. Applicant reserves the right to pursue the withdrawn claims in one or more divisional applications.

It is submitted that these claims, as originally presented, were in full compliance with the requirements 35 U.S.C. §112. Support for this amendment is provided throughout the Specification as originally filed. No new matter has been introduced by this amendment. Changes to claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which the Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-12, 13-19, 32-43, 44-50 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by WO 99/12349 to Hendricks et al. (hereinafter merely "Hendricks").

Claims 25, 26, 29, 30 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,600,725 to Roy (hereinafter merely "Roy").

Independent claim 3, recites, *inter alia*:

"A communication control apparatus

wherein said control means determines the type of advertising information to be provided in accordance with an instruction from a communication apparatus and controls communication so as to transmit a signal for providing the determined type of said advertising information to said communication apparatuses" (emphasis added)

As understood by Applicant, Hendricks relates to a method and apparatus for communicating multiple live video feeds over the internet. Users may be able to view a plurality of remote locations in real time. In another embodiment of the invention, users are able to remotely control a video picture of a distant location. The remote control may be either actual control of a remote video camera or perceived remote control by the manipulation of audiovisual data streams. Text, graphics, and other video information supplement one or more video pictures to provide an educational and entertaining system.

As understood by Applicant, Roy relates to an apparatus and method that allows the operator of each user device participating in a multimedia conference to selectively receive information services during the multimedia conference. The apparatus includes a controller for receiving start-up signals from a user device, sending start-up requests to destination user devices, and receiving start-up signals from the destination user devices. The start-up signals may include information as to whether each user device requests information services to be provided during the multimedia conference. The controller establishes the multimedia conference and selectively provides the information services to the respective user devices. The

information services are provided continuously or non-continuously at the preference of the user devices. The information services may also be provided in various formats at the preference of the user devices.

Applicant submits that nothing has been found in Hendricks or Roy that would teach or suggest the above-identified features of claim 1. Specifically, neither Hendricks nor Roy teaches or discloses a communication control apparatus wherein the control means determines the type of advertising information to be provided in accordance with an instruction from a communication apparatus and controls communication so as to transmit a signal for providing the determined type of the advertising information to the communication apparatuses, as recited in independent claim 1.

Therefore, Applicant submits that claim 1 is patentable.

For reasons similar to those described above with regard to independent claim 1, independent claims 11, 13, 25, 26, 29, 30 and 44, which are similar in scope to claim 1, are also believed to be patentable

III. REJECTIONS UNDER 35 U.S.C. § 103

Claims 20 and 51 were under 35 U.S.C. §103(a) as allegedly unpatentable over Hendricks in view of JP 405260193A to Ito. Claims 56-57, 58-60 and 61-62 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Roy in view of U.S. Patent No. 5,886,735 to Bullister (hereinafter merely "Bullister").

Initially, the Applicant would like to bring to the notice of the Examiner that a copy of cited reference JP 405260193A was not provided along with the Office Action.

Applicant respectfully requests a copy as well as the English translation of the cited reference for review.

Instant claim 56 recites *inter alia*:

“A communication control apparatus ... and second signals indicating pickup results in the directions of the users' perspectives to said plurality of communication apparatuses.” (emphasis added)

In paragraph 7 of the Office Action, the Examiner admits that Roy does not teach indicating pickup results in the direction of users' perspectives. However, the Examiner contends that it would have been obvious to one skilled in the art to modify Roy's system to provide for indicating pickup results in the direction of users' perspectives. Applicant respectfully disagrees.

Applicant respectfully submits that the claim 56 is patentable over the applied references for at least the following reasons.

A. No motivation or suggestion to combine cited references

Applicant submits that Roy, clearly, does not suggest the use of second signals indicating pickup results in the directions of the users' perspectives to the plurality of communication apparatuses. Therefore, there is no motivation for one skilled in the art to modify Roy's system with the video telephone headset of Bullister, when Roy does not teach or suggest indicating pickup results in the directions of the users' perspectives to the plurality of communication apparatuses.

MPEP §2145(X)(c) states:

As discussed in MPEP §2143.01, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings. The Federal Circuit has produced a number of decisions overturning

obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references, as discussed in the aforementioned section. (Emphasis added)

Therefore, Applicants respectfully submit that the Office Action has relied on impermissible hindsight. The motivation or teaching to make the claimed combination by modifying or combining prior art references must be found in the prior art and not in the Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Applicants submit that there is nothing that would motivate a skilled worker in the art to modify Roy in view of Bullister, when Roy lacks the very motivation to do so.

B. Impermissible hindsight reasoning and mosaic reconstruction

Applicants respectfully submit that *impermissible hindsight* reconstruction of the claimed invention using elements of the prior art is *not* allowed under 35 U.S.C. §103 (see MPEP §2142 for a discussion of impermissible hindsight).

Furthermore, MPEP §2143.01(III) states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Emphasis in original.)

Applicants respectfully submit that the Office Action has merely created a mosaic of features from the prior art, without either a clear motivation or a suggestion of the desirability of the combination.

Additionally, MPEP §2143.01(IV) states:

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some

objective reason to combine the teachings of the references. *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).
(Emphasis added)

As noted above, the Office Action has merely provided references to teach individual aspects of the claimed invention in total isolation, and has not established a *prima facie* case of obvious. The Office Action has failed to provide an objective reason to *combine* the disparate and unrelated teachings of the references into the claimed combination.

Furthermore, even if the Examiner has located all the limitations of the claimed present invention, still a fundamental notion of patent law is the concept that invention lies in the new combination of old elements. Therefore, a rule that every invention could be rejected as obvious by merely locating each element of the invention in the prior art and combining the references to formulate an obviousness rejection is inconsistent with the very nature of "invention."

Consequently, a rule exists that a combination of references made to establish a *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention. The inquiry is not whether each element existed in the prior art, but whether the invention as a whole is obvious in light of the prior art. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 100, 2 U.S.P.Q.2d 1826 (Fed. Cir. 1987).

For at least the foregoing reasons, claim 56 is believed to be patentable and should therefore be allowed. For similar reasons independent claims 58 and 61, which are similar in scope with claim 56, are also allowable.

IV. DEPENDENT CLAIMS

The other claims are each dependent from one of the independent claims discussed above and are therefore believed patentable for at least the above-identified reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

In the event the Examiner disagrees with any of the statements appearing above with respect to the disclosures in the cited references, it is respectfully requested that the Examiner specifically indicate the portion, or portions, of the reference, or references, providing the basis for a contrary view.

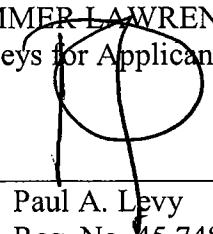
In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Please charge any fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

Respectfully submitted,

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